

### **REMARKS/ARGUMENTS**

Applicant would like to thank the Examiner for the careful consideration given the present application.

Claims 12 and 13 have been amended.

Claims 12 and 13 are rejected under 35 U.S.C. 112, second paragraph. Claims 12 and 13 have been amended to overcome the rejection.

Claims 3, 7 and 10–11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. (U.S. Patent 6,389,672) in view of Busler (U.S. Patent 3,431,548). For at least the following reasons, the Examiner's rejection is respectfully traversed.

The Office Action has not establish a *prima facie* case of obviousness, because there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Busler with Ishii to arrive at the claimed invention.

The Office Action states, "To modify the tape of Ishii et al. employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already know in the art, the advantages of connecting and aligning being described by Busler" (Office Action, 06/09/2006, page 3). The Office Action also states that "since both prior art references pertain to joining carrier tapes, their combination is maintained to have been obvious to do to one of ordinary skill in the art" (Office Action, 06/09/2006, page 6). However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Feb. Cir. 1990).

In Ishii, the holder units 10 are joined to each other by couplers 8a, 8b that connect, align, and hold the holder units 10 to form a tape-like member ( col. 4, lines 30–46; Figs. 5(a)–5(d)).

In Busler, carrier strips are joined to each other by aligning and connecting a snap member 43 and a receptacle 44 located at the ends of the carrier strip (col. 2, lines 25–32; Figs. 1–2).

Since the Ishii couplers 8a, 8b already connect, align, and hold the holder units 10 to form a tape-like member 1, there is no advantage in substituting the couplers 8a, 8b for a different connecting structure that would also merely connect, align, and hold the holder units. Thus, there is no advantage in substituting the Ishii couplers 8a, 8b with the Busler snap member 43 and receptacle 44 elements. Since there is no advantage in substituting the Ishii couplers 8a, 8b with the Busler snap member 43 and receptacle 44 elements, modifying the Ishii holder units to have the connecting structure of the Busler carrier strips would not have been an obvious substitution as stated by the Office Action. Therefore, although a rational for combining reference may be a recognition in the prior art that some advantage that would have been produced by the combination, the Office Action has not established such a recognition or advantage.

There is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Busler with Ishii to arrive at the claimed invention. Therefore, the Office Action has not establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection of the claims based upon the combination of references is respectfully requested.

Claims 12–13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 07165260 in view of Busler (U.S. Patent 3,431,548). For at least the following reasons, the Examiner's rejection is respectfully traversed.

The Office Action has not establish a *prima facie* case of obviousness, because there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine EP 07165260 with Ishii to arrive at the claimed invention.

The Office Action states, "To modify the tape member of EP 07165260 employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning

and holding structures already know in the art, the advantages of connecting and aligning being described by Busler” (Office Action, 06/09/2006, page 4). However, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In EP 07165260, carrier tap pieces are aligned, connected, and held to each other by a connecting structure, which is a cutout part K at one end and a complementary engagement at the other end (Abstract). In Busler, carrier strips are joined to each other by aligning and connecting a snap member 43 and a receptacle 44 located at the ends of the carrier strip col. 2, lines 25–32; Figs. 1–2).

Since the EP 07165260 cutout part and complementary engagement aligns, connects, and holds the carrier tape pieces, there is no advantage in substituting such a connecting structure for a different connecting structure that would also merely connect, align, and hold the carrier tape pieces. Thus, there is no advantage in substituting the EP 07165260 connecting structure with the Busler snap member 43 and receptacle 44 elements. Since there is no advantage in substituting the EP 07165620 connecting structure with the Busler snap member 43 and receptacle 44 elements, modifying the EP 07165260 carrier tape pieces to have the connecting structure of the Busler carrier strips would not have been an obvious substitution as stated by the Office Action. Therefore, although a rational for combining reference may be a recognition in the prior art that some advantage that would have been produced by the combination, the Office Action has not established such a recognition or advantage.

There is no suggestion or motivation for one skilled in the art at the time the invention was made to combine Busler with Ishii to arrive at the claimed invention. Therefore, the Office Action has not establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejection of the claims based upon the combination of references is respectfully requested.

With regards to claim 12, none of the references disclose or suggest “a plurality of feed holes formed at a constant pitch for feeding the tape member feed hole by feed hole in the tape feeder arrangement” *and* “wherein a feed hole is provided on the locked member attachment and locked member attachment at a position at which a positional relationship of the feed hole with a contiguous feed hole corresponds with a regular feed hole of the tape members at said constant pitch.” Similar language is found in claim 13.

In EP 07165260, the carrier tap pieces are aligned, connected, and held to each other by a connecting structure, which is a cutout part K at one end and a complementary engagement at the other end (Abstract). EP 07165260 discloses feed holes 6 formed at a constant pitch on the carrier tape pieces. However, EP 07165260 does not disclose a feed hole on both parts of the connecting structure. Therefore, EP 07165260 fails disclose or suggest feed holes for feeding the tape feeder arrangement provided on a locked member attachment and a locked member attachment as in the claimed invention. Busler does not overcome the deficiencies of EP 07165260.

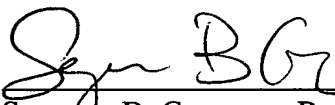
In Busler, carrier strips are joined to each other by aligning and connecting a snap member 43 and a receptacle 44 located at the ends of the carrier strip (col. 2, lines 25–32; Figs. 1–2). Busler discloses that holes 50 on the carrier strip are evenly spaced and include the receptacle 44 and a hole 45 in the snap member 43 (col. 2, lines 62–72). However, the Busler holes 50 do not feed the carrier strip in the pod-applying machine. Rather, Busler discloses slots 49 that are evenly spaced for feed fingers of the pod-applying machine (col. 2, lines 62–72). However, the Busler slots 49 are not provided on the snap member 43 and receptacle 44. Therefore, Busler fails to disclose or suggest feed holes for feeding the tape feeder arrangement provided on a locked member attachment and a locked member attachment as in the claimed

invention. Thus, even if combined, the references do not disclose or suggest all the elements of the claimed invention.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36261.

Respectfully submitted,  
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